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EXAMINER

MILIA, MARK R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICIA S. KRUSE

Appeal 2009-0964
Application 09/929,430
Technology Center 2600

Decided:¹ March 24, 2009

Before MAHSHID D. SAADAT, CARLA M. KRIVAK, and ELENI
MANTIS MERCADER, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-32, which are all of the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellant's invention relates to a method for organizing and automating a presentation printing process by defining a presentation print job profile wherein a user adds a plurality of files to a presentation print job profile, specifying packaging and printing characteristics with respect to individual ones of the files. Responsive to a single print request, each of the files in the presentation profile is printed based on the specified packaging and printing characteristics (Spec. 3:1-8).

Independent claim 1 is representative and reads as follows:

1. A method comprising:

adding a plurality of files to a presentation profile;

specifying a set of individual printing characteristics with respect to each of the files;

specifying a set of individual packaging characteristics with respect to each of the files; and

responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

The Examiner relies on the following prior art in rejecting the claims:

Hicks	US 5,481,353	Jan. 2, 1996
Salgado	US 5,579,087	Nov. 26, 1996
Kanerva	US 6,026,416	Feb. 15, 2000

Claims 1, 4, 6-9, 12, 14-17, 20, 22-25, 28, and 30-32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Salgado.

Claims 2, 10, 18, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado and Kanevra.

Claims 3, 5, 11, 13, 19, 21, 27, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado and Hicks.²

Rather than repeat the arguments here, we make reference to the Briefs (App. Br. filed Jun. 25, 2007; Reply Br. filed Dec. 21, 2007) and the Answer (mailed Oct. 31, 2007) for the respective positions of Appellant and the Examiner.

ISSUE

Appellant argues (App. Br. 20) that Salgado in column 5, lines 40-54 specifies print job parameters for the entire print job and does not specify parameters for each individual segment. Appellant asserts (Reply Br. 3) that while Salgado selects printing characteristics (e.g., paper type, print quality) on a segment-by-segment basis, packaging characteristics (e.g., quantity) are selected on a global basis.

The issue specifically turns on whether Salgado anticipates Appellant's claimed invention by disclosing printing a presentation package that is based on the individual packaging characteristics and individual

² In the Examiner's Answer, the 35 U.S.C. § 101 rejection of claims 1-32 was withdrawn by the Examiner. (*See* Ans. 3).

printing characteristics corresponding to each of the files in response to a single print request, as recited in claim 1.

FINDINGS OF FACT

1. Salgado relates to constructing a multi-segment print job by entering a start build print job function at the network interface, identifying each segment of the print job including segment location, specifying print job characteristics such as quantity and quality for each segment, entering an end build print job function at the network interface, and identifying a printing device on the network whereby each segment of the print job is accessed and distributed to the printing device in order to complete the multi-segment print job. (Abstract; col. 2, ll. 50-60).

2. The multi-segment print job corresponding to a multi-sectioned document in Salgado is assembled by an operator at any user interface on the network from multiple local and remote sources by entering a start build print job function at the network interface, identifying each segment of the print job including segment location, specifying print job characteristics such as paper stock and quality for each segment, and entering an end build print job function at the network interface. (Col. 5, ll. 31-50).

3. Salgado then identifies and selects a printing device on the network and provides *features relating to the entire document*, such as quantity, in order that each segment of the print job is accessed and distributed to the printing device to complete the multi-segment print job. Emphasis added. (Col. 5, ll. 50-54).

4. Salgado discloses that the operator determines and selects the particular printing device or facsimile device appropriate to accomplish the

job requirement, wherein the operator can select more than one document destination. (Col. 6, ll. 54-67).

5. As shown in Figure 7, Salgado discloses a flow chart for processing a number of segments to complete a printing job where at step 272 the destination of the selected segments is identified and at step 274 the job parameters or attributes to complete the job are selected. (Col. 7, ll. 22-44).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). See also *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

ANALYSIS

We disagree with the Examiner’s argument (Ans. 9) that because a print job can *potentially* be sent to and printed by a different printer, each job on a different printer carries with it an associated packaging characteristic. We observe that the Examiner takes the position that different segments that may be retrieved from different storage locations necessarily have different

packaging characteristics (*id.*). While different printers may be designated as destinations to complete the print job (FF 4), the Examiner has not identified any teaching in Salgado to show that individual packaging characteristics are used for each segment. The Examiner relies on column 7, lines 11-53 to further assert (Ans. 9) that each segment has its individual packaging characteristics as the segments are sent to a number of different printing devices.

As argued by Appellant (Reply Br. 3), even if different segments of the print job were to be performed by different devices, individual packaging characteristics would not have been inherently required for each segment. In fact, Salgado, while identifying different printing devices on a network where different segment are to be printed, merely specifies printing characteristics for each segment (FF 1 and 2). However, when it is time to specify the packaging characteristics, Salgado discloses doing so for the *entire document*, instead of separately for each segment (FF 3).

To the extent that the operator may select more than one printer as the document destination (FF 4), Salgado does not specifically disclose that different packaging characteristics are also specified for each destination. In that regard, we also disagree with the Examiner's reasoning (Ans. 9) that each segment in the collection of separate segments that form a complete job, as disclosed in column 7, lines 11-53, has its own printing and packaging characteristics. In fact, the portion of Salgado relied on by the Examiner discloses that while different segments are assembled to form a job, it is the collection of the selected segments that is sent to the destination with the specified printing and packaging characteristics (FF 5). The characteristics specified in step 274 of Figure 7 are selected after the

segments are put together and therefore relate to the collection of segments and not to each individual segment, as recited in claim 1.

CONCLUSION

On the record before us, we find that the Examiner fails to make a prima facie case that Salgado anticipates claim 1 by disclosing printing a presentation package that is based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files in response to a single print request. Therefore, in view of our analysis above, the 35 U.S.C. § 102 rejection of claim 1 or other independent claims 9, 17, and 25 that include similar limitations, as well as claims 4, 6-8, 12, 14-16, 20, 22-24, 28, and 30-32 dependent thereon, as anticipated by Salgado cannot be sustained. Additionally, we do not sustain the 35 U.S.C. § 103 rejection of claims 2, 10, 18, and 26 over Salgado and Kanevra, nor of claims 3, 5, 11, 13, 19, 21, 27, and 29 over Salgado and Hicks since the Examiner has not identified any teachings in the secondary references related to the individual packaging characteristics and individual printing characteristics corresponding to each of the files to overcome the deficiencies of Salgado discussed above.

ORDER

The decision of the Examiner rejecting claims 1-32 is reversed.

REVERSED

Appeal 2009-0964
Application 09/929,430

babc

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400